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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,451	04/24/2001	Kuniaki Kawamura	199/49908	1890

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EXAMINER

BORISSOV, IGOR N

ART UNIT PAPER NUMBER

3639

DATE MAILED: 02/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/840,451	<b>Applicant(s)</b> KAWAMURA ET AL.	
	<b>Examiner</b> Igor Borissov	<b>Art Unit</b> 3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 November 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 13,15-17 and 19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13,15-17 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

Amendment received on 11/16/2005 is acknowledged and entered. Claim 1-12, 14 and 18 have previously been canceled. Claim 19 has been amended. Claims 13, 15-17 and 19 are currently pending in the application.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 13, 15-17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wobler (Marketing to a New Generation (leasing of heat pumps)) in view of Sandelman et al. (US 6,211,782) and further in view of Brandimarte (US 3,802,216).**

**Claim 13.** Wobler appears to teach a method for leasing heat pumps, comprising:

providing (directing) installation by a contractor (administrator) a heating or cooling equipment (heat pump) to a user on a lease base (page 1, L. 17; page 2, L. 17-20, 34-35);

identifying variations of heating and cooling usage of the installed equipment (page 2, L. 24-26);

determining lease charges based on said identified variations of heating and cooling (page 2, L. 24-26; page 3, L. 6-8).

Wobler does not teach monitoring said installed equipment over the Internet; and determining on the administrator side at least one of whether to change a number of

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units provided to the user or whether to replace at least one of the units by a unit of different capacity. Also, while Wobler teaches providing (directing) installation by a contractor (administrator) a heating or cooling equipment to the user, Wobler does not explicitly teach providing (directing) installation of said "determined on the administrator side" heating or cooling equipment (heat pump) to the user. Also, Wobler does not teach that said heating or cooling equipment is portable one.

Sandelman et al. (Sandelman) teaches a method for remotely monitoring heating, ventilating and cooling equipment over the Internet, including transmitting data regarding operating condition of the equipment to a central location (C. 3, L. 13-20); providing recommendations as to which model or brand of equipment is best suited for a particular site (C. 1, L. 43-44).

Brandimarte teaches a portable air conditioner and heating unit, which is small and compact, and adapted to be easily transported, installed or removed (C. 1, L. 19-22).

It would have been obvious to one having ordinary skill in the art to modify Wobler to include monitoring said installed equipment over the Internet, as disclosed in Sandelman, because it would advantageously prevent the contractor (administrator) from remaining on-site all the time (Sandelman; C. 1, L. 35-36). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Wobler and Sandelman to include providing recommendations regarding the appropriate type of equipment, as disclosed in Sandelman, because it would advantageously allow to prevent use of the equipment in excess of the design specification for the equipment, thereby preventing the premature failure of the equipment (Sandelman; C. 4, L. 28-29). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Wobler and Sandelman to include that said providing (directing) installation by a contractor (administrator) a heating or cooling equipment (heat pump) to a user on a lease base includes providing (directing) installation of said "recommended by the central location" a heating or cooling equipment, because it would allow to prevent the premature failure of the equipment (Sandelman; C. 4, L. 28-29). And it would have been obvious to one

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having ordinary skill in the art at the time the invention was made to modify Wobler and Sandelman to include that said heating or cooling unit is a portable one, as disclosed in Brandimarte, because it would advantageously allow to provide temporary means for cooling or heating a selected room which does not justify a permanent air-conditioning installation (Brnadimarte; C. 1, L. 6-9).

**Claim 15.** Wobler teaches said method for leasing heat pumps, wherein the user's lease charges are based on said identified (monitored) amount of heating and cooling used by the user and maintenance of said equipment (page 2, L. 24-26, 30; page 3, L. 6-8).

**Claim 16.** Sandelman teaches said method, including providing recommendations as to which model or brand of equipment is best suited for a particular site (C. 1, L. 43-44). Sandelman does not teach that said recommendations include "an increase in a number of units provided to the user; or replacement of at least one of the units by a unit with a larger heating or cooling capacity". However, Sandelman does teach that said monitoring of said equipment includes determining whether said equipment operates too often (C. 4, L. 26), and that said recommendations pertain to which model or brand of equipment is best suited for a particular site, and anticipation of the failure of an already-installed equipment based on how long it is running (C. 1, L. 43-46). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Wobler and Sandelman to include that said recommendations include a recommendation to "increase a number of units provided to the user; or replace at least one of the units by a unit with a larger heating or cooling capacity", because it would advantageously allow to prevent use of the equipment in excess of the design specification for the equipment.

**Claim 17.** Sandelman teaches said method, including providing recommendations as to which model or brand of equipment is best suited for a particular site (C. 1, L. 43-44). Sandelman does not teach that said recommendations include "a decrease in a number of units provided to the user; or replacement of at least

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one of the units by a unit with a smaller heating or cooling capacity". However, Sandelman does teach that said monitoring of said equipment includes determining whether said equipment operates too infrequently (C. 4, L. 26-27), and that said recommendations pertain to which model or brand of equipment is best suited for a particular site (C. 1, L. 43-44). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Wobler and Sandelman to include that said recommendations include a recommendation to "decrease a number of units provided to the user; or replace at least one of the units by a unit with a smaller heating or cooling capacity", because it would advantageously improve the feasibility of the project.

**Claim 19.** Brandimarte teaches said portable, self-contained air conditioner and heating unit including an evaporative unit and condenser unit, wherein in cooling mode, the evaporator unit is placed in the area to be air-conditioned, and in the heating mode, the positions of the evaporator and condenser units are reversed so to allow a heat pumping cycle or refrigeration cycle to be performed in the unit except heat rejection or absorption to heat or cool a secondary load side (C. 4, L. 10-18).

### ***Response to Arguments***

Applicant's arguments filed 11/16/2005 have been fully considered but they are not persuasive.

In response to applicant's argument that Wobler fails to suggest actual monitoring of the variations in actual heating or cooling, it is noted that Wobler teaches charging customers for the energy consumed (page 2, lines 21-23), thereby implying monitoring of said variations in actual heating or cooling. As per step "monitoring each of the units via the Internet to identify a variation in an amount of heating or cooling used by the user from each unit at an administrator side of the network" per se, Sandelman was applied for this feature (C. 3, L. 13-20).

In response to applicant's argument that Wobler fails to suggest paying monthly fee based on the customer's heating and cooling power use, it is noted that Wobler teaches that charges for the heating or cooling usage are embedded in the kWh charge during the life-cycle of the equipment so that revenue are generated from the lease as well as from the sale of energy (page 2, lines 21-35). The fluctuation in energy use would reflect the fluctuation in the heating or cooling usage.

In response to applicant's argument that in Sandelman there is no suggestion in message-forwarding service for the remote monitoring of variations in heating or cooling use for any purpose, the examiner points out that Sandelman specifically teaches that messages regarding monitored parameters of the heating or cooling equipment are transmitted to a central location for determining what to do next (C. 3, L. 13-2041-60). The advantages of said arrangement is that installation recommendations could be made as to which model or brand of equipment is best suited for a particular site, or determination could be made the failure of the equipment is expected based on how long said equipment is running. Providing recommendations based on the results of said monitoring (C. 1, L. 43-47).

In response to applicant's argument that the concept of "monitoring of heating/cooling equipment for the purpose of determining whether to change out units to improve efficiency" was "gleaned" from the present application in a reference, without regard to what the reference would actually teach, the examiner stipulates that Sandelman specifically teaches monitoring operating parameters of the heating or cooling equipment to estimate the working condition of the equipment based on how long said equipment is running, which, in turn, indicates which equipment operates under the stress. And providing recommendations which model or brand of equipment is best suited for a particular site furthermore suggest "efficiency" feature (C. 1, L. 43-47).

In response to applicant's argument that Brandimarte does not teach the inventive features, it is noted that Brandimarte was applied to show that said heating or cooling equipment could exist in a portable configuration (See a discussion above).

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

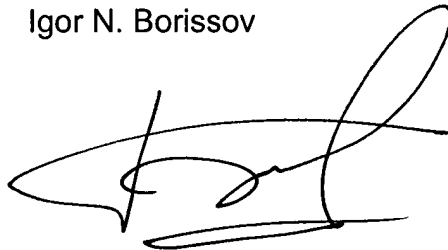


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Primary Examiner

Igor N. Borissov

A handwritten signature in black ink, appearing to be 'Igor N. Borissov', with a large, stylized loop at the end.

IB  
2/03/2006